

REMARKS

Claims 1-21 were originally filed in this application. In this response, claims 1, 3, 4, 6-9, 12, 13, 15-17 and 21 have been amended. No claims have been deleted or added. Consequently, claims 1-21 remain under consideration. Support for the amendments to the claims can be found, for example, at page 2, lines 24-32 and page 3, lines 8-11 of the specification and in the drawings. Therefore, no new matter has been added.

The Office Action indicates that it is a final action. The present office action is a first action on the merits in this application. The Applicant's attorney telephonically contacted the Examiner who confirmed that the designation of the office action as a final action was in error and that the action is a non-final action. The Applicant thanks the Examiner for his assistance and its response is to a non-final action.

Claims 1, 4, 6, 7, 9-13, 15, 16, 18-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,149,156 to Feola (referred to below as "Feola").

More particularly, the office action provides with respect to the independent claims 1, 12 and 21 as follows:

Claim 1. Feola discloses a controller for controlling a plurality of positions for displaying a combination of symbols, a controller, including a processor for processing data and displaying data on the display; and a selector operable by a player of the machine for enabling the player to select at least one feature which can be added to the base game played on the machine wherein an additional credit is staked by the player in order to be eligible for the feature. *See Fig. 7-10; Col. 2:53-59; 3:18-20; 6:54-7:15; 8:50-55.*

Claim 12. Feola discloses a controller for controlling a plurality of positions for displaying a combination of symbols, a controller including a processor for processing data and displaying data on the display; and a selector operable by a player of the machine for enabling the player to select at least one feature which can be added to the base game played on the machine wherein an additional credit is staked by the player in order to be eligible for the feature being a fixed amount multiplied by a bet wagered per draw. *See Fig. 7-10; Col. 2:53-59; 3:18-20; 6:54-7:15; 8:50-55.* Feola allows a player to wager a fixed amount for each additional game a player elects to play. The claim does not require that the fixed amount be predetermined. Nor does it require a number of draws in each game. Thus, Feola meets the limitations of the claim.

Claim 21. Feola discloses a controller for controlling a plurality of positions for displaying a combination of symbols, a controller including a processor for processing data and displaying data on the display; and a plurality of selectors operable by a player enabling the player, prior to making a base bet, for selecting a range of features to be added to a base game played on the machine to enable the player to tailor the game to the player's requirements. *See Fig. 7-10; Col. 2:53-59; 3:18-20; 6:54-7:15; 8:50-55.*

As discussed in the abstract of Feola, a card game has multiple rounds and a number of locations on a displayed grid of hidden, randomly-selected cards for each chosen round. Each round has rules different from the other rounds. Cards revealed at the chosen locations and at randomly selected locations are used to play the chosen rounds. Payouts are determined by the number of player-chosen locations that matches the number of randomly selected locations and/or by the hand formed by the randomly selected cards revealed in the player-chosen locations.

More particularly, as described at Col. 2:53-58 individual games are combined as rounds into a single combination game. This is done by the player firstly choosing which rounds the player will participate in, which locations to play for each round and the amount to wager for each chosen round. Thus, the player in Feola never chooses additional features to be added to a base game in order to "build" a game. In Feola, the player chooses merely chooses variations of features which are pre-integrated into the game.

Consequently, Feola does not teach the integer of "enabling a player to select at least one additional feature **which can be added** to a base game played on the machine" (Applicant's emphasis). Feola therefore teaches a player making a selection of one or more pre-defined variable parts of the game, such as selecting a predetermined number of locations on a grid. There is therefore no teaching in Feola of adding additional features to a base game. Moreover, there is no teaching in Feola that "a first bet configuration provides eligibility for the base game alone and at least one other bet configuration provides eligibility for the base game enhanced with eligibility for the at least one additional feature" as now claimed in claims 1 and 12 or "a first selection providing eligibility for the base game alone and at least one other selection providing eligibility for the base game enhanced with eligibility for at least one additional feature" as now claimed in claim 21.

The Examiner quotes Col. 3:18-20 as being of relevance. However, all that this passage discloses is that the game can be played on a variety of media, including scratch or pull tab tickets and electronic media such as public and private video systems and stand-alone machines. It does not disclose any of the features of the present invention as claimed in any one of claims 1, 12 or 21. What is disclosed at Col. 6: 54-7:15 is what Feola refers to as a combination game. Importantly, that passage specifies that it is the house which determines the exact rules of the combination game. There is no player selection involved. The only player selection is selecting

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which rounds the player will participate in and the amount to wager for each chosen round. The "amount to wager" does not refer to paying an additional credit for eligibility for additional features added to a base game. The amount to wager as taught by Feola is merely a monetary amount which the player can choose to wager. For example, as with a conventional slot machine, a player can wager one coin, three coins, five coins or ten coins on each payline. This is the manner in which the terminology of "an amount to wager" is used in Feola. This also applies to Col. 8:50-55.

In each of the independent claims, it is explicitly stated that the player can select at least one additional feature or a range of additional features which is added to a base game. The selected additional feature or features therefore subsequently form part of a base game or arise on the occurrence of a trigger condition in the base game. None of this is taught or suggested by Feola.

Specifically, in so far as claim 12 is concerned, the Applicant respectfully disagrees with the Examiner's conclusions. It is irrelevant whether or not claim 12 requires a fixed amount or that the fixed amount be predetermined. It is irrelevant whether or not claim 12 requires a number of draws in each game. Neither of these aspects relate to the selection by a player of at least one additional feature to be added to a base game wherein a first bet configuration provides eligibility for a base game alone and a second bet configuration provides eligibility for the base game enhanced with eligibility for the at least one additional feature. Accordingly, Feola, respectfully does not meet the limitations of present claim 12.

Further, it is well established that in respect of a novelty objection, the prior art must disclose all the integers of the invention as claimed. ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Feola does not teach that a player can select at least one additional feature to add to the base game. Feola also does not teach the feature of a player wagering a first bet configuration in order to be eligible for the base game alone or at least one other bet configuration to be eligible for the base game has enhanced by eligibility for the at least one additional feature (claims 1 and

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12) or a first selection providing eligibility for the base game alone and at least one other selection providing eligibility for the base game enhanced with eligibility for at least one additional feature (claim 21). In the circumstances, it is respectfully submitted that Feola does not constitute an anticipation of the present invention as claimed in independent claims 1, 12 and 21 as currently amended and that Claims 1, 12, and 21 are allowable under the requirements of 35 U.S.C. § 102(e) over Feola.

As claims 4, 6, 7, 9-11, 13, 15, 16, 18-20 depend from allowable base claims, it is submitted that these claims are similarly in an allowable format.

The Examiner also rejected Claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Feola in view of Piechowiak US 5,807,172 and further in view of Guttman US 5,354,069. As noted above, the Applicant does not believe that Feola teaches “a gaming machine which includes ... a selector operable by a player of the machine for enabling the player to select at least one additional feature which can be added to a base game played on the machine such that a first bet configuration provides eligibility for the base game alone and at least one other bet configuration provides a eligibility for the base game enhanced with eligibility for the at least one additional feature” (Claim 1 as currently amended) and further that the combined teachings of Feola, Piechowiak, and Guttman taken in combination also fail to teach the claimed invention. Thus, as Claims 2 and 3 properly further limit and depend from the amended Claim 1, the Applicant believes that Claims 2 and 3 are patentable under the requirements of 35 U.S.C. § 103(a) over the combined teachings of Feola, Piechowiak, and Guttman.

The Examiner also rejected Claims 5, 8, 14, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Feola in view of Carter US 6,582,305 and further in view of Yoseloff US 6,312,334. The Applicant similarly believes that the combination of Feola with Carter and Yoseloff also fail to teach or suggest the claimed limitations of “a gaming machine which includes ... a selector operable by a player of the machine for enabling the player to select at least one additional feature which can be added to a base game played on the machine such that a first bet configuration provides eligibility for the base game alone and at least one other bet configuration provides a eligibility for the base game enhanced with eligibility for the at least one additional feature” (Claim 1 as currently amended). Thus, similarly the Applicant believes that Claims 5 and 8 depending from Claim 1 and Claims 14 and 17 depending from Claim 12 are

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patentable under the requirements of 35 U.S.C. § 103(a) over the combined teachings of Feola, Carter, and Yoseloff taken in any combination.

In the circumstances, Applicant respectfully requests withdrawal of the rejection of the claims under 35 USC 102(e) and 35 USC 103(a).

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SUMMARY

Applicant believes that this paper is fully responsive to each matter of substance raised in the Office Action and believes that the case is in condition for allowance. Withdrawal of the rejections and allowance of the application is therefore courteously solicited. Should the Examiner have any requests, questions or suggestions to facilitate the allowance of the application, the Examiner is invited to contact Applicant's representative at the telephone number listed below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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